

The petition for reconsideration under 37 CFR 1.181(a)(2) is **granted** to the extent that the November 15, 2000, decision to merge has been reviewed, but is **denied** with respect to making any change therein.

REVIEW OF FACTS

1. U.S. Patent No. 5,554,121 (the '121 patent) issued to Ainsworth et al on September 10, 1996.
2. On April 9, 1997, a first request for reexamination of the '121 patent was filed by a third party requester and was assigned Control No. 90/004,602 (the '4602 proceeding).
3. On June 5, 1997, reexamination was ordered in the '4602 proceeding.
4. *Ex parte* prosecution was then conducted in the '4602 proceeding, and the proceeding terminated with the issuance of a Notice of Intent to Issue Reexamination Certificate (NIRC) on January 20, 1998.
5. On March 23, 1998, a second request for reexamination of the '121 patent was filed by a third party requester, David M. Crompton, and was assigned Control No. 90/004,946 (the '4946 proceeding).
6. Reexamination was ordered in the '4946 proceeding on June 8, 1998.
7. A first reexamination certificate issued in the '4602 proceeding on July 14, 1998, confirming patent claims 1-6 and adding new claims 7-17.
8. On August 28, 1998, a reissue application was filed and assigned application no. 09/143,503. The reissue application amended the specification, abstract, and claim 15, and it added new claims 18-56.

9. A notice of allowance was mailed in the reissue application on April 6, 2000, and a notice that a reissue patent would issue was published in the *Official Gazette* on September 19, 2000.
10. On November 15, 2000, a decision to merge the reissue application and the '4946 reexamination proceeding was issued by the Director of the Office of Patent Legal Administration. In the decision, the April 6, 2000, Notice of Allowance for the reissue application was withdrawn after the payment of the issue fee. Also, a housekeeping amendment was required of applicant/patent owner to place the same amendments in both the reissue and reexamination proceedings.
11. On December 18, 2000, patent owner filed the present petition for reconsideration of the November 15, 2000, decision to merge.

DECISION

In support of the request for reconsideration, the present petition advances several arguments as to why merger would not be appropriate in the present instance. These arguments will be addressed in the order presented by the petition.

1) At page 2 of the petition, it is argued that the ordered merger violates the 35 U.S.C. 305 proscription of amended or new claims that broaden or enlarge the scope of the patent claims. This argument is directed to the housekeeping amendment requirement (made in the merger decision) to place the same amendments in both the reissue and reexamination proceedings; the requirement would result in the physical placement (entry) of the broadening claims of the reissue application into the reexamination file.

In response to this argument, a discussion is in order of the nature of the housekeeping amendment placing the same amendments in both proceedings. 37 CFR 1.565(d) states:

" If a reissue application and a reexamination proceeding on which an order pursuant to 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings. **Where merger of a reissue application and a reexamination proceeding is ordered, the merged examination will be conducted in accordance with 1.171 through 1.179 and the patent owner will be required to place and maintain the same claims in the reissue application and the reexamination proceeding during the pendency of the merged proceeding.** The examiners actions and any responses by the patent owner in a merged proceeding will apply to both the reissue application and the reexamination proceeding and be physically entered into both files. Any reexamination proceeding merged with a reissue application shall be terminated by the grant of the reissued patent. " [Emphasis added]

In the merged proceeding, it is the reissue aspect of the proceeding that permits the providing of broadened claims. Once broadened claims are permitted for the proceeding as a whole, their presence in the reexamination file is only a reflection of the dual nature of the merged proceeding. The physical presence of the broadened claims in the reexamination file does not signify that broadened claims are present in a reexamination proceeding, but rather that broadened claims are present in a merged proceeding which permits such claims. The physical presence of the broadened claims in the reexamination is simply a display of the composite set of claims that exists in the merged proceeding. If the proceeding ceases to be merged (i.e., if the merger is dissolved), the broadened claims must be removed from the reexamination file, since there is no longer a dual nature (reexamination and reissue) to the proceeding. As stated in MPEP 2285, "[u]pon dissolution of the merged proceeding ... any new grounds of rejection which are applicable under reexamination (e.g., improper broadened claims) should be made by the examiner."

Accordingly, there is no violation of the 35 U.S.C. 305 proscription against broadening where applicant/patent owner provides the same claims in both proceedings. It is merely a consistent display of what is permitted by the dual nature

of the merged proceeding, and any broadening will be removed when and if the merged proceeding is dissolved. As to why the housekeeping amendment is required by 37 CFR 1.565(d), it has, as its purpose, the avoidance of confusion in referring to the claims, as well as inconsistency and potential conflict of claims for the same patent.

2) At page 3 of the petition, it is argued that the ordered merger does not promote uniformity. Petitioner points out that reexamination was ordered only for claims 1-6 (the claims present in the reexamination). On the other hand, the reissue deals with claims 7-56. Petitioner appears to be urging that the reissue will resolve patentability issues as to claims 7-56, while the reexamination will resolve such issues as to claims 1-6 (since reexamination was ordered for claims 1-6, only those claims will be reexamined); thus, combining the two proceedings dealing with the different claims can potentially result in non-uniformity of treatment of claims 1-6 already allowed in the reissue application.

As to petitioner's contention that the reexamination is limited to claims 1-6, MPEP 2216 points out that "[i]f a substantial new question of patentability is found as to one claim, all claims will be reexamined during the ex parte reexamination process." Thus, all claims for the '121 patent will be examined. As to what those claims are, such is presently open to doubt in view of the existence of different sets of claims in the different proceedings. As pointed out in the decision ordering merger, a review of the reissue application shows amendment of the specification, abstract and claim 15, and addition of new claims 18-56. On the other hand, the '4946 reexamination file contains only original patent claims 1-6. Claims 7-17 added by the reexamination certificate issued in the '4602 proceeding on July 14, 1998 are present in the reissue application but not in the reexamination file. Accordingly, the claims are not identical in both proceedings.

The same claims must be examined for both proceedings. Thus, they must be in both proceedings. As long as the claims are not the same, the claims do not particularly point out the invention of the patent, and there is an impermissible lack of uniformity between the proceedings.

3) At pages 3-5 of the petition, it is argued that the merger ordered by the Office has slowed down the reissue application which is "already complete," and that the status of the reissue application as complete makes it inappropriate to merge the application with the reexamination proceeding "which is just beginning." Petitioner contends that "there is nothing left to do in the reissue application, other than printing the reissued patent." Further, petitioner urges that the merger "will not expedite the prosecution of the reexamination" and is "not necessary to address the prior art raised in the second reexamination request."

These arguments are not persuasive.

Once the reexamination has been filed and ordered, the information cited in the reexamination proceeding must, **at some point**, be "reviewed" in conjunction with that present in the reissue application. The question is: When is that point in time? In answer to that question, note the following. It would not be in the interest of the public for the Office to reissue the patent prior to doing this "review," because this could possibly result in the reissue of the '121 patent despite the presence of art cited in reexamination which renders claims unpatentable. Yet, as pointed out above, applicant has an interest in the fast issuance of the reissue patent. The most expeditious manner to balance these interests is to merge the proceedings. Addressing the delay of the reissue application in a merged proceeding, MPEP 2285 directs the examiner to issue his/her Office action "at the most advanced point possible" for the reissue application. If, upon consideration of the art cited in both the reissue application and the reexamination, the examiner finds the claims to be patentable, a Notice of Allowance will be promptly issued for the proceeding, and it will be processed into a reissue patent (that will also serve as the reexamination certificate for the patent). If, on the other hand, the art cited in the reissue application and the reexamination renders claims unpatentable, the examiner's Office action will open prosecution to resolve the issues.

Thus, if the claims are found patentable the patent will be reissued as fast as possible, given the circumstances. If the claims are not found patentable, then the time needed to resolve the patentability issues will be spent, as it should be.

Also to be noted is that the merger will ensure that prior art considered in the reissue application can be adequately addressed as to any **new** considerations, interpretations, and information supplied by the '4946 reexamination request. If the reissue application were permitted to be concluded by the issuance of a reissue patent prior to addressing the positions set forth in the '4946 reexamination, then prior art considered in the prosecution of the reissue application can become barred from use in the reexamination proceeding. *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997).

In view of the above, it cannot be said that the consideration of the reissue application is "already complete," because the information in the reexamination proceeding remains to be considered to complete the process.

4) At pages 5-6 of the petition, the argument as to the advanced stage of the reissue application vis-a-vis the earlier stage of the reexamination is augmented with a contention that it is unfair to applicant to delay issuance of a reissue patent while the reexamination proceeding (in its early stages) is carried out. Petitioner urges that patent owner will unfairly lose valuable "intervening rights" as a result of the merger, and that "this situation did not result from any action or inaction on the part of the patentee." This argument is apparently made in conjunction with the earlier argument that it "might have made sense to merge the second ['4946] reexamination" with the reissue application and assign them to the same examiner in 1998; but it should not be done at this point, since the reissue prosecution has progressed far beyond that of the reexamination.

This argument is not persuasive in view of the following.

The '4946 request for reexamination of the '121 patent was filed

On March 23, 1998, and reexamination was ordered in the '4946 proceeding on June 8, 1998. The present reissue application was filed August 28, 1998. A review of the record reveals that the filing of the reissue application did not include a notification of the existence of copending reexamination '4946 filed approximately 5 months prior to the reissue application. The record of the reissue does not reveal any notification of the reexamination that would have alerted the Office of same, such that the proceedings could be merged at the early stage referred to by petitioner. Rather, applicant/patent owner prosecuted the reissue application independently of the reexamination, knowing that the reexamination proceeding was not moving forward. Petitioner cannot now persuasively complain that the two proceedings should have been merged earlier, since applicant/patent owner chose to conduct the prosecution separately, without notification to the Office of the existence of and relationship of the reexamination proceeding.

It is noted further that first notification to the Office of the reissue was not provided in the reexamination proceeding until October 28, 1999, after the claims in the reissue application had been found allowable over the art cited in that application. Applicant knew full well that different examiners had charge of the reexamination proceeding and the reissue application. Yet applicant/patent owner waited until one of the examiners found the claims allowable, so that applicant/patent owner could present that finding to the second examiner. If the reissue application were now permitted to be issued to thereby conclude the reissue proceeding, the second examiner would be bound by the findings as to the art in the reissue proceeding (as discussed above), without being given a chance to view those same references in light of the argument presented in the reexamination by the third party. This is not deemed equitable, especially since applicant/patent owner could easily have brought to the Office's attention the existence of and relationship of the two proceedings much earlier so that all information (in the two proceedings) could be considered together as a package by a single examiner, or at least such that the two examiners could have conferred and had knowledge of all the information in both files.

Summary:

In view of the above discussion, the petition for reconsideration (of the November 15, 2000, decision to merge

the reissue application and '4946 reexamination proceeding) is not persuasive. Merger is deemed to be the most effective vehicle, and the appropriate avenue, to handle the two proceedings (the reissue application and the '4946 reexamination) given the above-discussed situation and analysis.

REQUIREMENT FOR SAME AMENDMENTS IN BOTH PROCEEDINGS

In the November 15, 2000, decision to merge the reissue application and reexamination proceeding, the patent owner/applicant was required to maintain identical amendments in the reissue and the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in the two files was, and is, required as long as the proceedings remain merged. See 37 CFR 1.565(d).

Patent owner/applicant did not comply with the requirement, and instead traversed it. The traverse is not found persuasive for the reasons set forth above in the present decision. **Accordingly, the requirement is hereby made final.**

A proposed housekeeping amendment **must be filed within ONE (1) month of the mailing date of this decision**, to thereby place the same amendments in both cases. The housekeeping amendment should not address the issue of patentability. See 37 CFR 1.540.

In view of the finality of the requirement, any future paper filed by patent owner/applicant which does not comply with the requirement will not be considered and may be returned to patent owner/applicant.

CONCLUSION

1. The Notice of Allowance mailed April 6, 2000, in the reissue application remains withdrawn, and the reissue and reexamination proceedings remain merged.

2. The present petition for reconsideration under 37 CFR 1.181(a)(2) is **granted** to the extent that the November 15, 2000, decision to merge made by the Director of the Office of Patent Legal Administration has been reviewed, but is **denied** with respect to making any change therein.
3. The reissue and reexamination files are being forwarded to the examiner via the Director of Technology Center 3700. Upon receipt of same, the examiner should not issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding until the expiration of ONE (1) month from the mailing of **the present decision**, to permit submission of a proposed housekeeping amendment to thereby place the same amendments in both cases.
4. Telephone inquiries related to this decision should be directed to Kenneth Schor, Senior Legal Advisor, at (703) 308-6710.



Robert J. Spar, Director
Office of Patent Legal Administration

February 14, 2001
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